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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,628	06/28/2001	Susumu Nakagawa	450100-03297	6151
20999	7590	12/01/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			GREENE, DANIEL L	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 12/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/894,628	NAKAGAWA, SUSUMU	
	Examiner	Art Unit	
	Daniel L. Greene	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/13/2005 have been fully considered but they are not persuasive. The Applicant argues that Rabin does not teach or suggest that (a) warning report data are (sic) (is) sent to enable "anticipating an inability to utilize said contents". The Examiner disagrees in that Rabin teaches about supervision policies, for example Col. 20, lines 15-35. Rabin further teaches about the use of call-up and call-up records in conjunction with the guardian center that provides a continuation message sent to the user device's supervising program. see for example Col. 20, lines 50-55. It would of been obvious to one of ordinary skill in the art at the time of the invention, that the function of the supervision policies, the guardian center, the call-up and the device's supervising program could provide the indication that the use of the program is/has reached a certain milestone. The reference Saito was used to show that call-up could in fact be called warnings.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 7, 8, and 9 are rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In re John Covell Collier, 55CCPA-; 397 F.2d 1003; 158 USPQ 266, Claim-Indefiniteness- Combination- Structural Relationships Between Elements are not Positively Recited- 35 U.S.C. 112, second Paragraph. The statement in the claim “wherein said warning enables anticipating an inability to utilize said contents” is about intended uses, capabilities, and structures which will result upon the performance of future acts is not a positive structural limitation. The claim does not positively recite structural relationships of the elements in its recitation of what may or may not occur. In this sense it fails to comply with section 112, second paragraph, in failing distinctly to claim what applicant presents as his actual invention.

The main fault is indefiniteness in the sense that things, which may be done, are not required to be done. For example, enables, is not a positive limitation. Just because something is enabled does not mean that that something will or will not realize the enablement. The word, “anticipating”, refers to a future act/event that could or could not happen. The word, “inability” is indefinite because it does not specify why the action cannot happen be it lack of sufficient power, resource and or capacity. These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefor be relied on to distinguish from the prior art.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin et al. U.S. Patent 6,697,948 B1 [Rabin], and further in view of Saito U.S. Patent 6,182,218 B1 [Saito].

As per claims 1, 7, 8 and 9:

3. The new limitation "wherein said warning enables anticipating an inability to utilize said contents" renders the claims indefinite and therefore rejected as previously noted. However, the Examiner will interpret the limitation to mean a warning is given to alert the user that the contents usage has expired be it time or usage. As noted, Rabin teaches about supervision policies, for example Col. 20, lines 15-35. Rabin further teaches about the use of call-up and call-up records in conjunction with the guardian center that provides a continuation message sent to the user device's supervising program. see for example Col. 20, lines 50-55. It would of been obvious to one of ordinary skill in the art at the time of the invention, that the function of the supervision policies, the guardian center, the call-up and the device's supervising program could provide the indication that the use of the program is/has reached a certain milestone. The reference Saito was used to show that call-up could in fact be called warnings.

The recitation that “ A contents control method...” “ A contents control device...” “ A program storage medium for...” and “ A contents control apparatus...” has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause.

Kropa v. Robie, 88 USPQ 478 (CCPA 1951)

As per claims 1, 7, 8 and 9, Rabin discloses a method/apparatus that manages content (software) based on key code information (tags) containing content usage information (authorized vendor or owner rights to the software) set within a range that the contents can be utilized comprising:

comparing said content usage rights information with status code information showing the usage status of said contents; Col. 11, lines 10-45; The supervisory program determines the if the attempt to use the instance of software is allowable.

determining whether the contents are used within the range set by said content usage rights information; Col. 11, lines 10-45; The supervisory program determines the if the attempt to use the instance of software is allowable.

comparing said status code information with output setting information having a threshold value within the range of said contents usage rights information to warn by warning report data when in proximity to said contents usage rights in the case where said status code information is within the range of said contents usage rights

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information; Col. 11, lines 10-45; The supervisory program determines the if the attempt to use the instance of software is allowable.

Rabin discloses the claimed invention except for sending said warning report data to a report address using an electronic mail when said status code information nears the threshold value of said output setting information. However, Rabin does disclose sending a continuation message indicating an action to be followed. Col. 11, lines 50-55.

Saito teaches that it is known in the art to provide sending said warning report data to a report address using an electronic mail when said status code information nears the threshold value of said output setting information. Col. 10, lines 49-54. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the continuation message indicating an action to be followed of Rabin with the sending said warning report data to a report address using an electronic mail when said status code information nears the threshold value of said output setting information of Saito, in order to provide the user with information to be used for future actions.

disabling use of the contents when said status code information exceeds the threshold value of said output setting information; Col. 41, lines 8-12, Rabin teaches that the rejection of the user device simply means actions that can include discarding or removing or not allowing use of the instance of software. and

deleting the contents after a period of elapsed time for deletion has elapsed. Col. 41, lines 8-12. Rabin teaches that the rejection of the user device simply means actions that can include discarding or removing or not allowing use of the instance of software.

As per claim 2:

Rabin does not expressly show outputting invalidation report data when the use of said contents has been disabled. However, Rabin does disclose the use of the call-up and continuation message to convey the system's status to the user. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to outputting invalidation report data when the use of said contents has been disabled since it is known in the art that outputting invalidation report data when the use of said contents has been disabled is old and well known.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The outputting data when the use of said contents has been disabled steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to outputting invalidation report data when the use of said contents has been disabled because such data does not functionally relate to the

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steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 3:

Rabin does not expressly show outputting deletion report data when said contents have been are deleted. However, Rabin does disclose the use of the call-up and continuation message to convey the system's status to the user. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to outputting deletion report data when said contents have been are deleted since it is known in the art that outputting report data when the use of said contents has been deleted is old and well known.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The outputting data when the use of said contents has been deleted steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to outputting deletion report data when said contents have been are deleted because such data does not functionally relate to the steps in the

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method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Further, Rabin discloses the deletion of the instance of software and subsequent continuation message. for example Col. 41, lines 8-12.

As per claim 4:

Rabin further discloses:

wherein loading period information set with the loading timing for loading said contents usage right information, said status code information and said output setting information are set in said setting information, and said status code information, said contents usage information and said setting information are compared based on said loading interval information. for example Col. 7, lines 35-48.

As per claim 6:

Rabin does not expressly show sending said_invalidation report data and said deletion report data to said resort address using an electronic mail. However, Rabin does disclose the use of the call-up and continuation message to convey the system's status to the user. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to sending said_invalidation report data and said deletion report data to said resort address using an electronic mail is old and well known.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The sending said_invalidation report data and said deletion report data to said resort address using an electronic mail steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to sending said_invalidation report data and said deletion report data to said resort address using an electronic mail. because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

11/16/2005


SALVATORE CANGIALOSO
PRIMARY EXAMINER
ART UNIT 222